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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT PAPER NUMBER

3621

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,764

Applicant(s)

GRAINGER ET AL.

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17,38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17,38 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. This office action is in response to the restriction election filed on September 12, 2005. Claims 1-17 and 38-39 are pending. Claims 1-4 are amended. Claims 18-37 are canceled. Claims 38-39 are added.

Claim Objections

2. Claim 1 is objected to because of the following informalities: in line 3 the phrase "a electronic" should be "an electronic". Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-3 and 38-39 are rejected under 35 U.S.C. 102(a) as being anticipated by ePave User Guide, published by U. S. Patent and Trademark Office on January 12, 2000.

As to claim 1, ePave discloses a computer-implement method for securing intellectual property rights, the method comprising (page 1):

a) Providing, from a first server computer to a client computer, an electronic invention disclosure form to be filled out is taught by ePave as allowing a smart electronic invention disclosure form to be downloaded from USPTO's computer to a client computer, and the electronic invention disclosure form can be filled out (pages 1, 9, 12, 17-21);

- b) Actively prompting a user of the client computer to provide information corresponding to an invention into pre-selected fields of the electronic invention disclosure form (pages 19-21);
- c) Receiving a filled-out invention disclosure in electronic form on the first server is taught by ePave as submitting a filled-out invention disclosure in electronic form to USPTO's computer, and USPTO's computer will send acknowledgment receipt to the client computer upon receiving the form (pages 29-31, 49).
- d) Automatically converting the invention disclosure form into a form of a patent application in response to a single click instruction input by the user on the first client computer and received by the server (pages 18-19, 28-29).

As to claim 2, ePave discloses active prompting an inventor by the disclosure form to provide best modes known to the inventor for practicing an invention (pages 17-21, 51-52).

As to claim 3, ePave discloses active prompting an inventor by the disclosure form to provide detailed information required to enable one of ordinary skill to practice the invention (pages 17-21, 51-52).

Claims 38-39 are parallel with claim 1; thus they are rejected for the similar reason as claim 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over ePave User Guide, published by U. S. Patent and Trademark Office on January 12, 2000.

As to claim 4, ePave discloses the smart disclosure form prompts an inventor to input information in pre-selected fields (pages 18-19). EPave does not specifically state that prompting an inventor by the disclosure form to identify co-inventors if there are any. It would have been obvious to one of ordinary skill in the art to include the feature of identifying co-inventions if there are any in the system of ePave because it is well known in the art that lots of applications have multiple inventors, and all the names of the inventors along with their signatures are required to be included in the applications. Thus, in order to compliance with patent law/rule and to further avoid any legal issues about inventorship, one of ordinary skill in the art would have been motivated to include the feature of identifying co-inventors in the system of ePave.

As to claim 5, ePave discloses wherein information in pre-selected files of the invention disclosure form is selectively placed in a pre-selected location in said patent application (pages 18-19, 28-29).

As to claim 6, ePave discloses the single click also causes the patent application to be filed at a patent office (pages 28-29).

As to claim 7, ePave discloses the patent application is filed at the patent office electronically (pages 28-29).

As to claim 8, ePave discloses executing the patent application with a digital signature of an inventor, assignee, or registered patent practitioner before the patent application is filed (pages 19-20, 28-29).

As to claim 11, ePave discloses transmitting notification that the patent application was filed to an intellectual property server (pages 24-31).

7. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over ePave User Guide, published by U. S. Patent and Trademark Office on January 12, 2000 in view of Hsu et al., U. S. Patent 5,982,898.

As to claims 9-10, ePave discloses encrypting the patent application before submitting the patent office (page 33); maintaining a registry of public keys at the patent office (page 5); decrypting of the patent application by the patent office is inherent for the system of ePave because the patent office has to decrypt the patent application in order to read. EPave does not specifically teach encrypting the patent application with a private key of the inventor, assignee, or registered patent practitioner, and decrypting the patent application with a public key for the inventor, assignee, or registered patent practitioner. However, Hsu teaches using private key and public key to encrypt or decrypt information (abstract and Figs1-2). It would have been obvious to one of ordinary skill in the art at the time of the invention to allow ePave to include the feature of using private key and public key to encrypt or decrypt the patent application for preventing unauthorized access.

8. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over ePave User Guide, published by U. S. Patent and Trademark Office on January 12, 2000 in view of Whitmyer, Jr., U. S. Patent 6,182,078.

As to claims 12-14, ePave discloses a computer-implement method for securing intellectual property rights as discussed above. EPave does not specifically disclose automatic calendaring by the IP server of a deadline data for foreign filing under an international convention, transmitting a reminder communication from the IP server to a specified address at a specified time period before the deadline date, and automatic converting the provisional patent application to a non-provisional patent application. However, Whitmyer teach automatically generating a reminder regarding important events and transmitting the reminder to correspondent clients (column 3 lines 38-65 and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to allow ePave to include the function of generating a reminder regarding important events, such as priority filing deadlines and transmitting the reminder to correspondent patent applicants because it would remind the patent applicants to submit proper documents before these deadlines.

9. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over ePave User Guide, published by U. S. Patent and Trademark Office on January 12, 2000 in view of U. S. Patent Application Specification Authoring Guide for WordPerfect XML Template, published by U. S. Patent and Trademark Office on December 14, 1999.

As to claims 15-17, ePave discloses a method for electronically filing patent applications. EPave does not specifically disclose submitting drawings along with the electronic patent application. However, U. S. Patent Application Specification Authoring Guide for WordPerfect XML Template discloses this matter (page 26). It would have been obvious to one of ordinary skill in the art at the time of the invention to allow ePave

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to include the function of submitting drawings along with the electronic patent application so that the applicant can submit all the necessary information in one single transmission, this easy task would attract more applicants filing patent applications electronically.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is 571-272-6705. The examiner can normally be reached on M-Th (10:00-7:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Cheung
Primary Examiner
Art Unit 3621
November 23, 2005



MARY D. CHEUNG
PRIMARY EXAMINER

